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CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002

EXAMINER

JOSEPH, TONYA S

ART UNIT	PAPER NUMBER
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3628

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/717,893	Applicant(s) KAN, JONG-HEUM	
	Examiner Tonya Joseph	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A single claim which claims both an apparatus and the method steps of using the apparatus is rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. For Example, Claim 1 is directed to a barcode reader, a data input unit, a mail processing server, a forwarded mail information database and a returned mail information database and the process of using the mail processing server, forwarded mail information database and the returned mail information database.
4. Claim 5 contains the same deficiencies as claim 1 through dependency and as such, is rejected for the same reasons.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6, 8 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 6 and 12 recite the limitation, wherein the forwarded mail information comprising a recipient's address and the mail information, and the returned mail information comprises a reason for return of each mailpiece and the mail information. It is unclear whether the forwarded mail information comprising a recipient's address and the mail information, and the returned mail information is part or the body of the claim. For Examination purposes, Examiner is interpreting it to be excluded from the body of the claim.

8. Claim 8 recites the limitation, receiving forwarded mail information from a sender and making the forwarded mail information into a database. The use of the word forwarded promotes doubt as to whether the mail information has been truly, "forwarded" being sent to a subsequent destination or forwarded as in being sent to initially. For Examination purposes, Examiner is interpreting the word forwarded to mean being sent to initially and/or to a subsequent destination.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. U.S. Pre-Grant Publication No. 2002/0032612 A1 in view of Park et al. U.S. Pre-Grant Publication No. 2001/0010334 A1.

11. As per Claim 1, Williams teaches a **data input unit which generates and outputs a key signal** (see para.137 lines 5-7). The limitation, "*ordering a particular operation to be executed or receives and transmits particular data*" is merely a statement of intended use and as such is afforded little patentable weight; a **mail processing server connected to the communication network, the barcode printer, the barcode reader, and the data input unit** (see para. 140; para. 137 lines 5-11; para. 269 and Fig. 3A). The limitation, "*the mail processing server transmitting data to and receiving data from the communication network, arithmetically processing the mail information obtained by the barcode reader and various types of data received from the data input unit, manages the mail information and the data to be made into a database, and controlling elements of the system to perform predetermined operations*" is merely a statement of intended use and as such is afforded little patentable weight; and a **returned mail information database connected to the mail processing server** (see para. 156 and Figs. 4A, 4B and 3A); The limitation, "*the returned mail information database making returned mail information received from the mail processing server into a database, and extracting and outputting data in response to a request from the*

mail processing server" is merely a statement of intended use and as such is afforded little patentable weight. Williams does not explicitly teach a **barcode reader which reads a particular barcode on each returned mailpiece received from the mail center**. Park teaches a barcode reader which reads a particular barcode on each returned mailpiece received from the mail center (see para. 28 lines 1-9) Williams does not explicitly teach a **forwarded mail information database**; Park teaches a forwarded mail information database (see para. 28 lines 14-23). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Williams to include the teachings of Park in order to provide correct address information to a sender, as taught in Park para. 28 lines 27-31. The limitation, "*connected to the mail processing server, the forwarded mail information database making forwarded mail information received from the mail processing server into a database, and extracting and outputting data in response to a request from the mail processing server*" is merely a statement of intended use and as such is afforded little patentable weight.

12. As per Claim 2, Williams in view of Park teaches the system of claim 1 as described above. Williams further teaches wherein the mail processing server comprises: a barcode processor connected to the barcode reader (see para. 137 lines 8-11, Examiner is interpreting a barcode reader as having a barcode processor), The limitation, "the barcode processor sequentially transmitting the mail information obtained by the barcode reader along a predetermined path" is merely a statement of intended use and as such is afforded little patentable weight. an information processor connected to the data input unit and the barcode processor (see para. 137, Examiner is

interpreting a computer as an information processor); The limitation, "the information processor arithmetically processing the mail information received from the barcode processor and the various types of data received from the data input unit, managing the mail information and the data to be made into a database, and manages particular data to be transmitted to or received from the communication network" is merely a statement of intended use and as such is afforded little patentable weight.; and

a communication interface unit connected to the communication network and the information processor, the communication interface unit controlling an operation timing and a format of the particular data so that the particular data can be transmitted and received between the information processor and the communication network according to a predetermined communication protocol (see para. 138; 139 and Fig. 3A).

13. As per Claim 6, Williams in view of Park teaches the system of claim 1 as described above. Williams further teaches a reason for return of each mailpiece and the mail information (see para. 515 lines 1-7)

14. As per Claim 7, Williams in view of Park teaches the system of claim 1 as described above. Williams does not explicitly teach wherein the mail processing server reports a result of processing the returned mailpieces to the sender through the communication network (see para. 446 and 476), extracts recipient information from the returned mail information (see para. 455), and reports the recipient that a mailpiece having been forwarded to the recipient is returned through the communication network (see para. 532 lines 1-10 and 531).

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. U.S. Pre-Grant Publication No. 2002/0032612 A1 in view of Park et al. U.S. Pre-Grant Publication No. 2001/0010334 A1 in further view of Official Notice.

16. As per Claim 3, Williams in view of Park teaches the system of claim 1 as described above. Williams further teaches wherein the information collection barcode comprises the mail information, is a one-dimensional barcode or a two-dimensional barcode (see para. 270 lines 4-8 and Fig. 27A), Williams does not explicitly teach a one-dimensional barcode or a two-dimensional barcode is printed on a predetermined position on the envelope. Official Notice is taken that printing a one-dimensional barcode or a two-dimensional barcodes on a predetermined position on the envelope is old and well known in the art of postage. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Williams and Park to include the teachings of Official Notice to ensure bar coded information can be read when positioned on a conveyor.

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. U.S. Pre-Grant Publication No. 2002/0032612 A1 in view of Park et al. U.S. Pre-Grant Publication No. 2001/0010334 A1 in further view of Official Notice and Gardenswartz et al. U.S. Patent No. 6055573A.

18. As per Claim 4, Williams in view of Park in further view of Official Notice teaches the system of claim 3 as described above. Williams does not explicitly teach wherein the information collection barcode comprises a classification field, a company name field, a job name field, an agent company name field, a customer ID field, an e-mail address

field, and an "others" field containing other information. Gardenswartz teaches, preferably, the CID, (credit card numbers, debit card numbers, social security card numbers, driver's license numbers, checking account numbers, street addresses, names, e-mail addresses, telephone numbers, frequent customer card numbers, shopper card identifications (SCIDs), or shopper loyalty card numbers) is represented as a bar code so that it can be quickly scanned at checkout, although any other type of machine-readable (or non-machine readable) implementations for storing or displaying identifications may be used, including magnetic strip and computer or memory chips on a card (e.g., smart cards) (Col. 5 lines 44-60); Gardenswartz does not explicitly teach wherein the information collection barcode comprises a classification field, a company name field, a job name field, an agent company name field, a customer ID field, and an "others" field containing other information. However, it would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Williams and Park and Official Notice to include the teachings of Gardenswartz because when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). The limitation, *"for distinguishing a sender requesting forwarding of a large amount of mail by category; indicating the sender; for distinguishing mail content by type of job; indicating an agent company requested to forward the large amount of mail, indicating an ID of a customer who is managed by the sender and is supposed to receive the*

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relevant mailpiece; indicating the customer's e-mail address" is merely a statement of intended use and as such is provided little patentable weight.

19. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. U.S. Pre-Grant Publication No. 2002/0032612 A1 in view of Park et al. U.S. Pre-Grant Publication No. 2001/0010334 A1 in further view of Gardenswartz et al. U.S. Patent No. 6055573A.

20. As per Claim 5, Williams in view of Park teaches the system of claim 1 as described above. Williams does not explicitly teach wherein the information collection barcode comprises a classification field, a company name field, a job name field, an agent company name field, a customer ID field, an e-mail address field, and an "others" field containing other information. Gardenswartz teaches, preferably, the CID, (credit card numbers, debit card numbers, social security card numbers, driver's license numbers, checking account numbers, street addresses, names, e-mail addresses, telephone numbers, frequent customer card numbers, shopper card identifications (SCIDs), or shopper loyalty card numbers) is represented as a bar code so that it can be quickly scanned at checkout, although any other type of machine-readable (or non-machine readable) implementations for storing or displaying identifications may be used, including magnetic strip and computer or memory chips on a card (e.g., smart cards (Col. 5 lines 44-60); Gardenswartz does not explicitly teach wherein the information collection barcode comprises a classification field, a company name field, a job name field, an agent company name field, a customer ID field, and an "others" field containing other information. However, it would have been prima facie obvious to one of

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ordinary skill in the art at the time of invention to modify the systems of Williams and Park to include the teachings of Gardenswartz because when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). The limitation, *"for distinguishing a sender requesting forwarding of a large amount of mail by category; indicating the sender; for distinguishing mail content by type of job; indicating an agent company requested to forward the large amount of mail, indicating an ID of a customer who is managed by the sender and is supposed to receive the relevant mailpiece; indicating the customer's e-mail address"* is merely a statement of intended use and as such is provided little patentable weight.

21. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable Park et al. U.S. Pre-Grant Publication No. 2001/0010334 A1 in further view of Official Notice.

22. As per Claim 8, Park teaches receiving forwarded mail information and making the forwarded mail information into a database (see para. 28 lines 15 -19); extracting a recipient's address and corresponding mail information from the forwarded mail information (see para. 28 lines 4-19), printing a zip code number barcode and an information collection barcode (see para. 30 lines 11-20), and reporting mail shipment to the sender (see para. 12 lines 1-10); receiving returned mailpieces (see para. 28 lines 1-10), sorting the returned mailpieces by reason for return (see para. 22 lines 27-31), and recording a reason for return of each returned mailpiece (see para. 26 lines 14-17);

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reading the information collection barcode printed on each returned mailpiece and making returned mail information into a database (see para. 28 lines 4-30); and reporting a result of processing the returned mailpieces to the sender through the communication network (see para. 33), extracting recipient information from the returned mail information (see para. 28 lines 4-19),, and reporting a corresponding recipient through the communication network that a mailpiece having been forwarded to the recipient is returned (see para. 33). Park does not explicitly teach printing on predetermined positions respectively, on an envelope. Official Notice is taken that printing on predetermined positions respectively, on an envelope is old and well known in the art of postage. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Park to include the teachings of Official Notice to ensure bar coded information can be read when positioned on a conveyor. *The limitation, "from the sender" is merely considered non-functional descriptive material and as such is afforded little patentable weight;*

23. As per Claim 12, Park in view of Official Notice teaches the method of claim 8 as described above. Park further teaches wherein the forwarded mail information comprises a reason for return of each mailpiece and the mail information (see para. 22 lines 27-31 and para. 26 lines 17-17).

24. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al. U.S. Pre-Grant Publication No. 2001/0010334 A1 in view of Official Notice in further view of Williams et al. U.S. Pre-Grant Publication No. 2002/0032612 A1 and Official Notice.

25. As per Claim 9, Park in view of Official Notice teaches the method of claim 8 as described above. Park does not explicitly teach the mail information, is a one-dimensional barcode or a two-dimensional barcode, and is printed on a predetermined position on the envelope. Williams teaches wherein the mail information, is a one-dimensional barcode or a two-dimensional barcode(see para. 270 lines 4-8 and Fig, 27A), Park does not explicitly teach a one-dimensional barcode or a two-dimensional barcode is printed on a predetermined position on the envelope. Official Notice is taken that printing a one-dimensional barcode or a two-dimensional barcode on a predetermined position on the envelope is old and well known in the art of postage. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the methods of Park and Official Notice to include the teachings of Williams and Official Notice to ensure bar coded information can be read when positioned on a conveyor.

26. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al. U.S. Pre-Grant Publication No. 2001/0010334 A1 in view of Official Notice in further view of Williams et al. U.S. Pre-Grant Publication No. 2002/0032612 A1 and Official Notice and Gardenswartz et al. U.S. Patent No. 6055573A.

27. As per Claim 10, Park in view of Official Notice in further view of Williams and Official Notice teaches the method of claim 9 as described above. Park does not explicitly teach wherein the information collection barcode comprises a classification field, a company name field, a job name field, an agent company name field, a customer ID field, an e-mail address field, and an "others" field containing other information.

Gardenswartz teaches, preferably, the CID, (credit card numbers, debit card numbers, social security card numbers, driver's license numbers, checking account numbers, street addresses, names, e-mail addresses, telephone numbers, frequent customer card numbers, shopper card identifications (SCIDs), or shopper loyalty card numbers) is represented as a bar code so that it can be quickly scanned at checkout, although any other type of machine-readable (or non-machine readable) implementations for storing or displaying identifications may be used, including magnetic strip and computer or memory chips on a card (e.g., smart cards (Col. 5 lines 44-60); Gardenswartz does not explicitly teach wherein the information collection barcode comprises a classification field, a company name field, a job name field, an agent company name field, a customer ID field, and an "others" field containing other information. However, it would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the methods of Park, Official Notice and Williams to include the teachings of Gardenswartz because when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). The limitation, *"for distinguishing a sender requesting forwarding of a large amount of mail by category; indicating the sender; for distinguishing mail content by type of job; indicating an agent company requested to forward the large amount of mail, indicating an ID of a customer who is managed by the sender and is supposed to receive the relevant mailpiece; indicating the customer's e-mail address"* is merely a statement of intended use and as such is provided little patentable weight.

28. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al. U.S. Pre-Grant Publication No. 2001/0010334 A1 in view of Official Notice in further view of Gardenswartz et al. U.S. Patent No. 6055573A.

29. As per Claim 11, Park in view of Official Notice teaches the method of claim 8 as described above. Park does not explicitly teach wherein the information collection barcode comprises a classification field, a company name field, a job name field, an agent company name field, a customer ID field, an e-mail address field, and an "others" field containing other information.. Gardenswartz teaches, preferably, the CID, (credit card numbers, debit card numbers, social security card numbers, driver's license numbers, checking account numbers, street addresses, names, e-mail addresses, telephone numbers, frequent customer card numbers, shopper card identifications (SCIDs), or shopper loyalty card numbers) is represented as a bar code so that it can be quickly scanned at checkout, although any other type of machine-readable (or non-machine readable) implementations for storing or displaying identifications may be used, including magnetic strip and computer or memory chips on a card (e.g., smart cards (Col. 5 lines 44-60); Gardenswartz does not explicitly teach wherein the information collection barcode comprises a classification field, a company name field, a job name field, an agent company name field, a customer ID field, and an "others" field containing other information. However, it would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the methods of Park and Official Notice to include the teachings of Gardenswartz because when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the

invention from the prior art in terms of patentability. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). The limitation, *"for distinguishing a sender requesting forwarding of a large amount of mail by category; indicating the sender; for distinguishing mail content by type of job; indicating an agent company requested to forward the large amount of mail, indicating an ID of a customer who is managed by the sender and is supposed to receive the relevant mailpiece; indicating the customer's e-mail address"* is merely a statement of intended use and as such is provided little patentable weight.

Conclusion

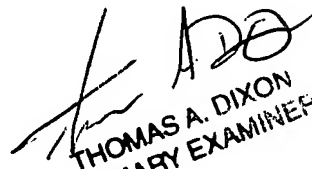
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonya Joseph whose telephone number is 571-270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph
Examiner
Art Unit 3628


THOMAS A. DIXON
PRIMARY EXAMINER